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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/522,869

01/28/2005

Akio Taniguchi

5404/95

5235

757

7590

08/22/2006

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EXAMINER

MULLIS, JEFFREY C

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/522,869	Applicant(s) TANIGUCHI ET AL.	
	Examiner Jeffrey C. Mullis	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6-8-06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-8, 11-22 and 26-29 is/are pending in the application.
- 4a) Of the above claim(s) 23-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-8, 11, 12, 15-22 and 26-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1-17-06</u> . | 6) <input type="checkbox"/> Other: _____ |

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12, 15, 22 and 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Madeleine (US 4,925,765).

Patentees disclose a block copolymer containing a block "A" which is preferably methacrylate or acrylate and a block "B" which is preferably methacrylate (column 3, lines 16-23) which is treated to form anhydride functionality from the (meth) acrylic units (Example 1). No examples of a block copolymer are present in which one block is acrylic and the other methacrylic. However, choice of such from the disclosure of the patent would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention in the expectation of adequate results, absent any showing of surprising or unexpected results.

Claims 1-12, 16, 18-22 and 26-29 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kazuhiko et al. (electronic translation of JP 11-349782).

Patentees disclose a process in which a block copolymer having a polyacrylate block and a polymethacrylate block is extruded at 240 degrees centigrade to form a sheet and as applicants as well as Madeleine, cited above both utilize similar processes for creating anhydride functionality in a methacrylic block copolymer, anhydride functionality would reasonably appear to be inherently produced in the reference examples. As the material is an adhesive it can reasonably be said to embrace a "seal". As films are produced, an automotive part can reasonably be said to be embraced, such as a film for covering a dashboard or protecting a PVC layer in a car.

When the reference discloses all the limitations of a claim except a property or function, and the Examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention, basis exists for shifting the burden of proof to applicant. Note In re Fitzgerald et al. 619 F. 2d 67, 70, 205 USPQ 594, 596, (CCPA 1980). See MPEP § 2112-2112.02.

Claims 1-12, 15-22 and 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matyjaszewski et al (either US 2002/0193538 or 20040204556) in view of Southwick (US 5,403,658).

Matyjaszewski et al. disclose polyacrylate-block-polymethacrylate block copolymers (see '538 at paragraph 101 and '556 at paragraph 502). Note the abstract of '538 for use as adhesives and paragraph 73 of '556 where crosslinking is disclosed. Use of ATRP is disclosed in the abstracts.

Southwick discloses an adhesive composition which can be crosslinked using methacrylate anhydride functionality in order to confer heat resistance at column 7, lines 40-53 and the paragraph bridging columns 10 and 11.

Matyjaszewski et al. do not disclose introduction of anhydride units derived from methacrylate units. However introduction of such into the product of '538 would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention in the expectation of conferring the heat resistance in an adhesive as disclosed by the secondary reference or achieving the crosslinking desired by '556 and means for achieving crosslinking disclosed by Southwick absent any showing of surprising or unexpected results.

The terminal disclaimer filed on 6-8-06 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of

10/477,868 has been reviewed and is accepted. The terminal disclaimer has been recorded.

The terminal disclaimer filed on 6-8-06 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 10/503,024 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Applicant's arguments filed 6-8-06 have been fully considered but they are not persuasive. With re to Madeleine applicants claims do not exclude AB or BAB or ABA type structures nor do the claims exclude the presence of the claimed block copolymers as part of a toner. It is not necessary that a reference relied upon in a rejection under 35 USC 103 be concerned with the same problems as an applicants.

Applicants amendment has overcome Miyashita.

With re to Kazuhiko, comparative examples 8-10 use specification examples 25-27 of the specification. However, these examples (for instance example 26 of page 138 of the instant specification) explicitly disclose block copolymers already having anhydride functionality and comparative examples 8-10 appear to remove such functionality. In any case comparative examples 8-10 do not use Kazuhikos' materials. Note EP 0318197 newly cited by applicants which discloses that heating for as little as 30 sec at 200 degrees centigrade results in anhydride functionality. Applicants may argue that amine catalyst is necessary but note page 5 of the patent disclosing that the amine only participates in the reaction step generating free carboxylic acid such as

Kazuhiko already contains. Example 1 of EP 0273397 newly cited by applicants similarly merely heats acrylic ester polymers. Kazuhiko therefore more than reasonably possesses the trace of anhydride (0.1%) required by the claims.

Kaneda has been withdrawn in view of applicants certified translations.

Matyjaszewskis' effective filing date is 4-11-1997, long prior to applicants'.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey C. Mullis whose telephone number is 571 272 1075. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seidleck James can be reached on 703 308 2462. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jeffrey C. Mullis
J Mullis
Art Unit 1711

JCM
8-9-06

JEFFREY C. MULLIS
PRIMARY EXAMINER
GROUP 1200

